<u>REMARKS</u>

Claims 1-29 are pending in this application. Claims 1, 26, and 29 are independent claims. Claims 1-29 stand rejected in the instant office action. Assignee traverses the rejections of the pending claims.

Claim Rejections - 35 U.S.C. § 103

Claims 1-2, 5-25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0115448, application of Bouchard (Bouchard) in view of U.S. Patent Application No. 2002/0199119, application of Dunnion, et al. (Dunnion). Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouchard in view of Dunnion and further in view of U.S. Patent No. 6,795,924, issued to Kiessling, et al. (Kiessling). Finally, claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunnion in view of U.S. Patent No. 6,397,261, issued to Eldridge, et al. (Eldridge). These rejections are traversed.

Claim 1 is directed to a method for handling secure message attachments for a mobile device wherein a secure message is processed at a server in order to locate a second attachment within the secure message. Claim 1 also recites that the processing of the secure message takes place only after the mobile device requests that the second attachment within the secure message be provided to the mobile device.

The office action maintains that claim 1 is unpatentable over Bouchard in view of Dunnion. Assignee respectfully disagrees that the cited references render obvious the claimed subject matter. In rejecting claim 1, the office action cites paragraphs 51 and 64-65 of Bouchard as disclosing the subject matter of claim 1, except for the applicability of

the subject matter to a mobile device. For example, the office action states that paragraphs 64-65 of Bouchard disclose requesting the second attachment at the mobile device. The cited passage from Bouchard reads:

> In more detail about the satellite e-mail server's processing of messages upon receipt and referring to FIG. 8 and FIG. 9, the secure message routing module 128 of the satellite e-mail server 212 includes a relay module 804, a secure reply module 808, and a message submit module 812. The relay module 804 enables the secure message routing module 128 to receive secure, encrypted messages from the master e-mail server 224, such as the second encrypted e-mail 540 (STEP 904). Upon receipt, the relay module 804 attempts to determine the intended recipient, such as the desktop computer 220, of the message 540. Thus, the relay module 804 determines if the secure message routing module 160 of the master e-mail server 224 encrypted the second encrypted e-mail 540 before transmitting it (STEP 908).

> If the master e-mail server 224 encrypted the message 540, the relay module 804 decrypts the second encrypted e-mail 540 (STEP 912). The relay module 804 then determines that the desktop 220 is the intended recipient of the third e-mail 532 (STEP 916). Once this is determined, the relay module 804 transmits the third e-mail 532 to the corporate e-mail server 216 for subsequent processing before the message's transmission to the desktop 220 (STEP 920). Thus, the secure message routing modules 128, 160 enable a message to be communicated securely without the recipient user having to perform any additional steps relative to the normal steps taken to send and receive a message.

By way of explanation, the office action states, "[I]n order for the server to process the message it has to be requested by the user." However, claim 1 is specifically directed to the mobile device providing a request for a second attachment (e.g., word processing document, image file, …; see claim 12) that is within a secure message. There is a significant difference between pushing the original message to a desktop, as taught by Bouchard, and a request for a second attachment contained within a secure message, as required by claim 1. Further, as the cited passage in Bouchard states, the disclosed secure message routing modules "enable a message to be communicated

securely without the recipient user having to perform <u>any additional steps relative to the</u> <u>normal steps taken to send and receive a message</u>." (Emphasis added.) Such a procedure likely would cause no difficulties in the context of a personal computer with a fast network connection. However, the same procedure could prove extremely problematic and/or costly in the context of a resource-constrained mobile device, such as that recited in claim 1 of the instant application. As the specification of the instant application states at page 13, lines 9-15:

> Because the mobile device 100 is typically resource-limited and in order to save bandwidth, the message server 106 may elect not to initially send the attachment 102 to the mobile device 100 over a wireless connector system 108. While viewing the message on the mobile device 100, a user can request that the message's associated attachment data 102 be transmitted to the mobile device 100 over the wireless connector system 108. It is noted that the wireless connector system 108 may include a wireless network, wireless gateway, and/or wide area network.

Thus, the message server, under the method recited in claim 1, would have the choice whether to send the attachment to the mobile device, independent of the sending of the original message within which the second attachment was located. In this way, the wireless network would not be burdened by the potentially unnecessary transmission of attachments, which can be quite large. Such a method also could save the users of the mobile devices within the network from bearing the monetary costs associated with downloading unnecessary data to the mobile device, and it could improve the perceived response time for message retrieval using a mobile device. For at least these reasons, the cited references do not render obvious the subject matter of claim 1. Thus, claim 1 is patentable over the cited references and should proceed to issuance.

The assignee disagrees with other positions in the office action as well. For example, claim 13 recites that the secure message without the second attachment is sent

from the server to the mobile device and the second attachment is provided to the mobile device based upon a request from the mobile device. In rejecting this claim, the office action cites paragraph 54, lines 9-12 and paragraph 56, lines 1-14 of Bouchard as disclosing the claimed subject matter. The cited passages from Bouchard read as follows:

> If, however, the corporate e-mail server 216 finds a matching address in the recipient address table 324, the corporate e-mail server 216 then searches for a rule associated with the recipient address in a rules table 328
>
> ...
>
> Referring to FIG. 5 and FIG. 6, the master e-mail server 224 then processes the message 304. The processing includes placing the first e-mail body 308 into another, second attachment or file 504 (STEP 604). The second file 504 may be a graphical file, textual file, e-mail, sound file, or any other file that can be transmitted across the network 112. The master e-mail server 224 then attaches the second file 504 to a second e-mail 508 (STEP 608). In one embodiment, the master e-mail server 224 generates a second e-mail body 512 for the second e-mail 508, such as text stating that the second e-mail 508 is delivered from the master e-mail server 224. Further, the second e-mail 508 also includes the first attachment 312 that the user wants to send to the recipient address 316.

These passages teach the steps a user would take to send an e-mail according to the procedure in Bouchard. Claim 13 recites that the secure message without the second attachment is sent from the server to the mobile device. Nothing in the cited passages discloses the claimed subject matter. The passages from Bouchard describe a typical e-mail system, where the message is "pushed" to the recipient all at once. Such a system does not disclose independently sending the original message within which the second attachment was located and providing the second attachment only in response to a request from the mobile device, as recited in claim 13. For at least these reasons, the cited references fail to render claim 13 obvious. Claim 13 thus is allowable and should proceed to issuance.

Claim 14 recites that a user of the mobile device requests that the second attachment be provided to the mobile device. As discussed above, this request is separate from a user's request to download the message within which the second attachment was located, which makes it possible to avoid unnecessarily downloading the data representing the second attachment and incurring the associated charges and delays. In rejecting claim 14, the office action cites paragraph 54, lines 9-12 and paragraph 56, lines 1-14 of Bouchard as disclosing the claimed subject matter.

As discussed above, these passages describe the steps taken by a user to send an e-mail according to the procedure disclosed in Bouchard. Claim 14 is directed to a request by a user (who is the e-mail <u>recipient</u>) to have the second attachment provided to the user's mobile device. In addition, as shown above, Bouchard teaches a procedure for providing message attachments that is transparent to the user. (See Abstract.) In other words, there is no mechanism in Bouchard to permit a user to request that an attachment be provided separately from the message within which the second attachment was located. In at least this way, Bouchard teaches away from the subject matter of the instant application. As the Supreme Court stated in the recent *KSR* case, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (citing *U.S. v. Adams*, 383 U.S. 39, 51-52 (1966)). Thus, for at least these reasons, the cited references fail to render obvious the subject matter of claim 14. Claim 14 therefore should proceed to issuance.

Claim 19 is directed to providing the second attachment to the mobile device automatically when the secure message is opened by the user of the mobile device. The

office action cited paragraph 65, lines 9-13 of Bouchard in rejecting claim 19. The cited

passage from Bouchard reads:

> Thus, the secure message routing modules 128, 160 enable a
> message to be communicated securely without the recipient user
> having to perform any additional steps relative to the normal steps
> taken to send and receive a message.

As discussed previously, and as the cited passage above makes clear, Bouchard

teaches a typical e-mail system, where the entirety of a message, including any

attachments, is "pushed" to a desktop at one time. Such a system does not disclose the

subject matter of claim 19, which recites that the second attachment is provided to the

mobile device when the original message (within which the second attachment was

located) is opened, rather than at the same time that the original message within which

the second attachment was located is sent to the mobile device. As above, this two-part

method permits time and cost savings compared to the traditional e-mail system disclosed

in Bouchard. For at least these reasons, claim 19 is not rendered obvious by the cited

references. Thus, claim 19 is allowable and should proceed to issuance.

Claim 26 is directed to an apparatus located at a computer server for handling

secure message attachments for a mobile device. In rejecting claim 26, the office action

cites the passage at paragraph 138, lines 1-5 of Dunnion as disclosing that a secure

message processing module looks into the secure message through the secure layer in

order to locate the second attachment, as required by claim 26. The passage from

Dunnion reads:

> The mail applet has obtained the user private key during the login
> protocol described above. This private key is used to decrypt the
> manifest attachment giving a triple-DES key. The mail applet then
> decrypts the content attachment using the triple-DES key just
> obtained.

The cited passage discloses neither a second attachment within a secure message that is received by a server as a first attachment nor a secure message processing module that searches for such a second attachment. Given this, the cited reference does not disclose this limitation of claim 26.

The office action cites paragraph 139, lines 1-14 of Dunnion as disclosing that the second attachment is provided to the mobile device, as required by claim 26. The cited passage from Dunnion reads:

> The decrypted message contains a signature that is now verified. The mail applet obtains the originator's public key from the server using the "Request user public key" function described in the table above. This key is used to verify the signature attached to the message. If this signature fails the user is informed that the message contents were not signed by the supposed originator of the message, thus providing authentication and non-repudiation. Another reason for the signature check to fail is that the message contents were altered, however in practice this cannot occur as the signature is wrapped in the encrypted content but it is included for future use (i.e. signed-only messages). The signature attachment is then removed from the message giving the unencrypted message composed by the originator.

To explain how the cited passage discloses the limitation of claim 26, the office action states that "the unencrypted message composed by the originator is provided to the user." In this passage, though, nothing discloses a second attachment within a secure message being provided to a mobile device. As discussed above with respect to claims 1 and 14, providing a decrypted message is not the same as, and does not disclose, providing an attachment that was attached to that message. Thus, the cited reference does not disclose this limitation of claim 26.

For at least the reasons set forth above, the cited references do not render obvious the subject matter of claim 26. Therefore, claim 26 is in condition for allowance and should proceed to issuance.
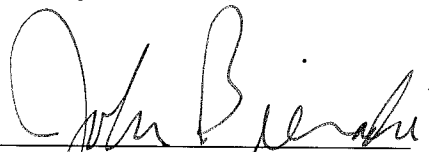
Independent claim 29 recites subject matter analogous to that of claims 1 and 26. The rationale in the office action for rejecting claim 29 is the same as that stated in the rejection of claim 1. Thus, for at least the reasons set forth herein with respect to claims 1 and 26, claim 29 also is allowable and should proceed to issuance.

Because independent claims 1, 26 and 29 are allowable, their respective dependent claims also are allowable and should proceed to issuance. It is noted that the assignee has not, at this time, presented arguments with respect to certain dependent claims in the instant application. The assignee nevertheless reserves the right to argue the patentability of all of the dependent claims in the instant application at a future time, should that become necessary.

CONCLUSION

For the foregoing reasons, assignee respectfully submits that the pending claims are allowable. Therefore, the examiner is respectfully requested to pass this case to issuance.

Respectfully submitted,

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